

## REMARKS

Claims 12, 14-16, 18-20, 22, and 52-78 were pending in this application. Claims 20 and 52-78 are withdrawn. In this response, Claims 12, 16 and 19 are amended. Claims 79 and 80 have been added. Thus, Claims 12, 14-16, 18, 19, 22, 79 and 80 are now pending and believed to be allowable in light of the amendments and remarks presented below.

The following observations were made by the Examiner in the pending Office Action are reproduced in part below for ease of reference:

- Non- Elected Claim
- Non-Elected by Original Presentation
- New Matter
- 35 U.S.C. 102
- 35 U.S.C. 103

### Non-Elected Claim

Applicant notes that the Examiner has not rejoined Claim 20. The Examiner's basis for not rejoining the claim is unstated. It is understood that the Examiner will postpone further discussion of withdrawn dependent Claim 20 until Claim 12 is found allowable.

### New Matter

The Examiner rejects Claim 12 "under the first paragraph of 35 USC 112 and 35 USC 132 as the specification as originally filed does not provide support for the invention as is now claimed. The terms 'to less than 0.2%' by weight of (dry solid...) of sulphonated dispersion agent is new matter. There is no literal support for "to less than 0.2% from the original disclosure." The Examiner does not state which requirement of 112, 1<sup>st</sup> paragraph is asserted in

support of the rejection, but the reference to 35 USC 132 suggests that it is based on a lack of written description.

The recited range is “0.05 to less than 0.2% by weight of dry solid of cementitious material of a sulphonated dispersion agent”, which finds support in the specification at page 5, line 25 and canceled original Claim 13 which recited “the dispersion agent is provided as 0.05-5% by weight of dry solids of cementitious material.” Thus, the currently recited range “0.05 to less than 0.2%” is within the range of “0.05-5%” identified in the specification and originally-filed claims. The recitation of “to less than 0.2%” is therefore fully within the range provided in the specification and therefore satisfies the description requirement. See M.P.E.P. § 2163.05(III) (discussing In re Wertheim, 191 USPQ 90 (CCPA 1976) (range of “25-60%” recited in the specification satisfies the description requirement for a narrower claimed limitation of “between 35% and 60%”).

The Examiner states that “applicants provide no examples for 0.2% or even less than this amount over a range of data points to support this newly added limitation. The applicants only have the teaching of the broad range and the endpoints.” (page 4). However, a “description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption.” M.P.E.P. § 2163.04 (citing In re Marzocchi, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971)). “The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims.” Id. (citing In re Wertheim, 541 F.2d, 257, 263, 191 USPQ 90, 97). It is respectfully submitted that the Examiner has not met his burden since no “sufficient evidence or reasoning”

has been provided as to why a person skilled in the art would *not* recognize in Applicant's disclosure a description of the claimed range defined by the claims. Applicant respectfully submits that the discussion of the specification and original claims above weighs strongly against the possibility that the burden could be established.

Additionally, the Examiner's states that "[t]here is no literal support for 'to less than 0.2% from the original disclosure.'" The Examiner appears to imply that there is a requirement that a claimed feature must have "literal support" in the specification. However, "the invention claimed does not have to be described in *ipsis verbis* in order to satisfy the description requirement of § 112." In re Lukach, 169 USPQ 795 (CCPA 1971). It appears that the M.P.E.P. does not require that a claim have "literal" support aside from negative limitations, (see M.P.E.P. § 2173.05(i)), which is inapplicable here.

It is respectfully submitted that this rejection was made in error, and Applicant respectfully requests that it be withdrawn.

### 35 U.S.C. § 102

The Examiner rejects Claims 12, 14-16, 18-19, and 22 are being anticipated under 35 U.S.C. 102(b) over Valore '231 ("Valore"), or Sobolev *et al.* '289 ("Sobolev"). The Applicant acknowledges with appreciation the withdraw of Rirsch and it is believed that the Examiner meant "cellulose ether" and not "cellulose" per se in describing the lack of disclosure in that reference. If this incorrect, the Examiner is respectfully requested to clarify the record.

Regarding Sobolev and Valore, the rejection of Claims 12, 14-16, 18-19 and 22 in view of these references were maintained on the basis of the new matter rejection (pages 3-4) that has

been addressed separately above. In view of the foregoing discussion, it is respectfully requested that the rejections of the claims in view of Sobolev, and Valore, be withdrawn.

For the sake of completeness, however, applicant incorporates its discussion of these references made in prior responses. As a courtesy, the discussion is substantially readdressed below. *Sobolev* provides “complex admixture” formulations in Tables 1 to 5. Table 3 describes an admixture having both a sulphonated DA and a cellulose ether VEA, and this admixture is used in cementitious formulations 3.1.1, 3.1.2, 3.2.1 and 3.2.2. The sulphonated DA in the formulation is the total of “hyperplasticizer” and “modified lignosulfate” that for each formulation is 1.14% (Formulation Nos. 3.1.1 and 3.1.2) or 2.54% (Formulation Nos. 3.2.1 and 3.2.2) and hence greater than the DA range recited in original and amended Claim 12 of “0.05-0.5” and “0.05 to less than 0.2”, respectively. As *Sobolev* does not teach a specific embodiment within Applicant’s claimed range in view of the foregoing, Applicant respectfully submits that *Sobolev* does not anticipate Claim 12. *Atofina v. Great Lakes Chemical Corp.*, 78 U.S.P.Q.2d 1417, 1423-24 (Fed. Cir. 2006) (holding that a genus cannot anticipate a species claim, including overlapping ranges between the claim at issue and the prior art, if the prior art does not disclose a specific embodiment within the claimed range). Further, *Sobolev* does not suggest or teach the claimed invention, specifically that the “dispersion agent is sufficient to increase the efficacy of the viscosity enhancing agent” and thus does not require that the DA increase the efficacy of the VEA during extrusion, as claimed. For the reasons mentioned above, it is believed also that for at least the reasons stated above Claim 12 is patentably distinguishable over *Sobolev* alone, or in combination with *Hayakawa* or *Downing*. As Claims 14-16, 18, 19, and 22 depend from Claim 12, it is believed that these claims are also patentably distinguishable.

35 U.S.C. § 103

The Examiner has rejected Claims 12, 14-19, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Hayakawa *et al.* '086 ("Hayakawa"), Valore, or Sobolev alone, or each in view of Downing *et al.* '199 ("Downing").

Hayakawa is asserted to teach all the limitations of Claim 12, except that it "does not teach the addition of a dispersant or dispersing agent such as sulfonated dispersant." (page 3 of the office action). It is asserted that "the addition of a dispersant to cement composition is a conventional additive to cement and its addition would have been an obvious design choice for one of ordinary skill in the art." (page 3). Regarding Hayakawa alone, while the Examiner may be correct (note: may) that one of ordinary skill would know to add dispersants to a cellulose fiber cement composition, it is an overextension to say that there is a suggestion to modify Hayakawa to provide a specified range, namely, "0.05 to less than 0.2% by weight of dry solid of cementitious material of a sulphonated dispersion agent", and it respectfully submitted that not all the limitations of Claim 12 are taught. (cf. M.P.E.P. § 2142). The Examiner asserts that it would have been an obvious design choice, but has not explained why a narrow concentration, viz, "0.05 to less than 0.2% by weight of dry solid of cementitious material of a sulphonated dispersion agent", would have been an obvious design choice. Regarding the combination of Hayakawa and Downing, it similarly does not establish a prima facie case since neither reference teaches or suggests the addition of "0.05 to less than 0.2% by weight of dry solid of cementitious material of a sulphonated dispersion agent", (and the combination also fails to teach that the agent in the claimed range would increase the efficacy of the cellulose ether), and it is

respectfully submitted that the combination of Hayakawa and Downing does not to establish a prima facie case.

For the reasons addressed above, Valore and Sobolev alone fail to teach, disclose or otherwise suggest all the limitations of Claim 12.

With respect to the combination of Valore with Downing, the Examiner in general refers Applicant to the final office action that was mailed June 19, 2007, for detailed analysis for matters other than the combination of Hayakawa and Downing. In that office action, the analysis included Valore alone, but does not appear to address its combination with Downing, and it is respectfully submitted that a prima facie case of obviousness accordingly has not been established.

With respect to the combination of Sobolev with Downing, it does not appear that the Examiner addressed the combination in the Office Action of June 19, 2007, accordingly, it is respectfully submitted that a prima facie case of obviousness has not been established.

#### Claim Amendments

Claims 12, 16 and 19 have been amended to replace “viscosity enhancing agent” with “cellulose ether”. New Claim 79 is presented to limit the group of cellulose ethers to avoid the prior art of record that do does not disclose these compounds in the ranges recited by Claim 12. New Claim 80 is similar to Claim 79 but recites a narrower range by reciting 3% as the lower end of the range of cellulose ether which is greater than apparently disclosed in the art of record. It is submitted that new Claims 79 and 80 are believed to be patentably distinguishable over the art of record.

Applicant has made a diligent effort to advance the prosecution of this application by amending the claims, describing herein how the claims distinguish over the prior art, and providing new claims that distinguish over the art. In light of the amendments and remarks presented above, Applicant submits that Claims 12, 14-16, 18, 19, 22, 79, and 80 are in condition for allowance, and requests favorable consideration and allowance of these claims.

Fees for a three-month extension of time is believed to be due and will be paid at the time this Amendment is filed. However, Applicant hereby authorizes the Commissioner to charge any additional fees or refunds that may be required by this paper to Deposit Account 07-0153.

Respectfully submitted,  
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